

TTAB



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF:

TRADEMARK: SYMBIO LACT (and leaf design)

Trademark Law Office: 101

Application Serial No. 75/583,411

Examining Attorney: Carol A. Spils, Esq.

Filed: November 5, 1998

Applicant: SYMBIO HERBORN GROUP GmbH & CO.

APPLICANT'S APPEAL BRIEF

BOX: TTAB

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington VA 22202--3513

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11:30

December 20, 2002

Applicant's Attorney

William H. Holt

Law Offices of William H. Holt  
Unit 2 - First Floor  
1423 Powhatan Street  
Alexandria VA 22314

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Applicant: SYMBIO HERBORN GROUP GmbH & CO.

Trademark: SYMBIO LACT (and Leaf Design)

Application Serial No. 75/583,411

APPLICANT'S APPEAL BRIEF

This is an appeal from the Examining Attorney's refusal to register the subject mark SYMBIO LACT (and Leaf Design), registration of which has been requested for the following goods:

- - PHARMACEUTICAL AND VETERINARY PRODUCTS, NAMELY, BIOLOGICAL CULTURES AND MEDIA FOR USE IN THE PRODUCTION OF NUTRITIONAL ADDITIVES FOR MEDICAL, FOR VETERINARY AND FOR SANITARY PURPOSES AND FOR THE CARE OF HEALTH, SUCH NUTRITIONAL ADDITIVES CONSISTING OF OR CONTAINING BACTERIAL AND/OR ENZYME PREPARATIONS; VITAMIN PREPARATIONS, ROUGHAGE AND MINERAL-FOOD SUPPLEMENTS; NAMELY, NUTRITIONAL SUPPLEMENTS, VITAMINS, MINERAL SUPPLEMENTS AND NUTRITIONAL ADDITIVES FOR ANIMAL AND HUMAN FOOD; PREPARATIONS OF TRACE ELEMENTS FOR HUMAN AND ANIMAL USE, NAMELY, NUTRITIONAL SUPPLEMENTS, NUTRITIONAL ADDITIVES CONTAINING VITAMIN PREPARATIONS AND/OR ROUGHAGE AND/OR MINERAL FOOD SUPPLEMENTS AND/OR TRACE ELEMENTS FOR MEDICAL, FOR VETERINARY, FOR SANITARY PURPOSES AND FOR THE CARE OF THE HEALTH, in International Class 005.

Applicant's mark, as presented in the application is as follows:



Applicant has submitted an appropriate disclaimer stating, "No claim is made to the exclusive right to use LACT apart from the mark as shown."

Applicant has claimed ownership of U.S. Registration 1,259,060 (for the WORD mark SYMBIOFLOR, in International Class 005, as shown in attached Exhibit 1 copied from the USPTO online database) and U.S. Registration 1,729,625, for the mark SYMBIO LACT (and "dot" design, as shown in the copy attached as Exhibit 2, now expired under Section 8; the identical mark being the pending subject matter of Application Serial No. 75/583,302, filed November 5, 1998 (simultaneously with the present application), and now allowed as is shown by the attached NOTICE OF ALLOWANCE (Exhibit 3), issued October 29, 2002, for goods in classes 005, 029 and 030.)

The Examining Attorney has refused registration under Section

2(d) because the mark for which registration is sought so resembles the mark shown in Reg. No. 0756724 (SYMBIO) as to be likely, when used on or in connection with the identified goods, to cause confusion, mistake, or to deceive.

It is applicant's contention that the mark SYMBIO is a weak mark in that a considerable number of Registrations have been granted for the identical mark and for variations of the word as is shown by the attached printout from the USPTO online database, showing a total of 79 files, comprised of 40 registrations (some now lapsed) and a total of 54 "LIVE" cases comprised of registrations and/or pending applications. Thus, it appears that marks comprised of SYMBIO, plus a distinguishing suffix, are appropriate for registration. In this regard, applicants obtained U.S. Registration No. 1,729,625 (SYMBIO LACT and dot design) in 1992 and received a Notice of Allowance for the identical mark in October of this year. Further, applicant is the owner of U.S. Registration 1,259,060 granted on November 29, 1983, for the word mark SYMBIOFLOR, for comparable goods in International Class 005, the registration being granted to applicant's subsidiary Symbiomed, Inc. (emphasis supplied.) Further, applicant's trade name comprises the word SYMBIO, coupled with the term "Herborn", which is the town in Germany of applicant's headquarters. Applicant's company has continued since its founding at Herborn, Germany in 1954. Thus, it is submitted that applicant's mark, SYMBIO LACT (and leaf design)


is clearly distinguishable from the registered mark SYMBIO, per se, was earlier registered in the U.S. back in November 1992, and should be passed to publication.

In addition, it is clear that the differences between applicant's mark SYMBIO LACT (and Leaf Design) and the cited mark SYMBIO, per se, are distinct from each other in all three of the trilogy of sound, appearance and meaning (the term "LACT" being part of applicant's mark, even though disclaimed separate and apart therefrom. Under long standing law, with no citation necessary, the marks must be considered in their entirety and when so considered, the Examining Attorney's rejection should be withdrawn.

In view of the foregoing, applicant submits that this Honorable Board should reverse the refusal under Section 2(b) so that the mark can be passed to publication and be re-registered to applicant, and such a decision is courteously solicited.

Respectfully submitted,

December 20, 2002

  
William H. Holt  
Applicant's Attorney

Law Offices of William H. Holt  
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1423 Powhatan Street  
Alexandria VA 22314  
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## Trademark Electronic Search System (TESS)

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**Logout** Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

**Check Status** (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

### Typed Drawing

**Word Mark** SYMBIOFLOR

**Goods and Services** IC 005. US 018. G & S: PHYSIOLOGICAL CULTURES OF STREPTOCOCCUS FAECALIS [ VAR. FAECALIS, LIFE CELLS ] \* OF HUMAN ORIGIN, VIABLE CELLS \* AND AUTOLYSATE THEREOF; PHYSIOLOGICAL CULTURES OF [ ESHERICHIA ] \* ESCHERICHIA \* COLI [ LIFE CELLS ] \* OF HUMAN ORIGIN, VIABLE CELLS \* AND AUTOLYSATE THEREOF; [ AND COMBINATIONS OF THESE PRECEDING CULTURES; KILLED R-FORMS OF HUMAN ESHERICHIA COLI, ] \* PHYSIOLOGICAL CULTURES OF ESCHERICHIA COLI AND STREPTOCOCCUS FAECALIS OF HUMAN ORIGIN, STERILE AUTOLYSATE THEREOF; PHYSIOLOGICAL CULTURES OF ESCHERICHIA COLI OF HUMAN ORIGIN, HEAT-KILLED R-FORMS THEREOF, \* WHICH CULTURES FORM BACTERIAL VACCINES FOR PRODUCING [ ANTIGENS ] \* ANTIBODIES \* IN THE HUMAN BODY. FIRST USE: 19540400. FIRST USE IN COMMERCE: 19801101

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 73305633

**Filing Date** April 13, 1981

**Published for** September 6, 1983

**Opposition**

**Change In Registration** CHANGE IN REGISTRATION HAS OCCURRED

Registration  
Number 1259060

Registration  
Date November 29, 1983

Owner (REGISTRANT) Symbiomed Inc. CORPORATION MISSOURI 812 Edgewood  
Columbia MISSOURI 65201

Assignment  
Recorded ASSIGNMENT RECORDED

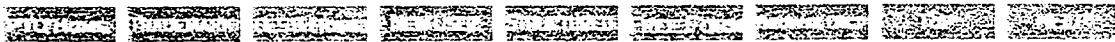
Attorney of  
Record ALAN E.J. BRANIGAN

Type of  
Mark TRADEMARK

Register PRINCIPAL

Affidavit  
Text SECT 15. SECT 8 (6-YR).

Live/Dead  
Indicator LIVE



Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 12/20/2002 21:53:13 ET

**Serial Number:** 73305633

**Registration Number:** 1259060

**Mark (words only):** SYMBIOFLOR

**Current Status:** A Section 8 affidavit has been accepted.

**Date of Status:** 1990-04-20

**Filing Date:** 1981-04-13

**Registration Date:** 1983-11-29

**Law Office Assigned:** TMEO Law Office = "

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov).

**Current Location:** 900 -Warehouse (Newington)

**Date In Location:** 1999-01-22

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### CURRENT APPLICANT(S)/OWNER(S)

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1. Symbioned Inc.

**Address:**

Symbioned Inc.  
312 Edgewood  
Columbia, MO 65201  
United States

**State or Country of Incorporation:** Missouri

**Legal Entity Type:** Corporation

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### GOODS AND/OR SERVICES

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PHYSIOLOGICAL CULTURES OF STREPTOCOCCUS FAECALIS \* OF HUMAN ORIGIN  
VIABLE CELLS \* AND AUTOLYSATE THEREOF; PHYSIOLOGICAL CULTURES OF \*  
ESCHERICHIA \* COLI \* OF HUMAN ORIGIN, VIABLE CELLS \* AND AUTOLYSATE



THEREOF; \* PHYSIOLOGICAL CULTURES OF ESCHERICHIA COLI AND STREPTOCOCCUS FAECALIS OF HUMAN ORIGIN. STERILE AUTOLYSATE THEREOF; PHYSIOLOGICAL CULTURES OF ESCHERICHIA COLI OF HUMAN ORIGIN. HEAT-KILLED R-FORMS THEREOF. \* WHICH CULTURES FORM BACTERIAL VACCINES FOR PRODUCING \* ANTIBODIES \* IN THE HUMAN BODY

**International Class:** 005

**First Use Date:** 19540400

**First Use in Commerce Date:** 19801101

**Basis:** 1(a)

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### ADDITIONAL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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1990-10-12 - Section 7 correction issued

1990-07-31 - Response received for Post Registration action

1990-07-06 - Post Registration action mailed - Section 7

1990-04-20 - Section 15 acknowledged

1990-04-20 - Section 8 (6-year) accepted

1990-04-13 - Response received for Post Registration action

1990-02-15 - Post Registration action mailed - Section 15

1989-09-15 - Section 7 amendment filed

1989-08-29 - Section 8 (6-year) filed

1989-08-18 - Section 15 affidavit received

1983-11-29 - Registered - Principal Register

1983-09-06 - Published for opposition

1983-11-29 - Registered - Principal Register

1983-09-06 - Published for opposition

1983-08-11 - Notice of publication

1983-08-10 - Notice of publication

1983-07-08 - Approved for Pub - Principal Register (Initial exam)

1983-07-07 - Case file assigned to examining attorney

1982-03-24 - Non-final action mailed

1982-03-09 - Case file assigned to examining attorney

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### CONTACT INFORMATION

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**Correspondent (Owner)**

ALAN E.J. BRANIGAN (Attorney of record)

ALAN E.J. BRANIGAN  
GRIFFIN, BRANIGAN & BUTLER  
P.O. BOX 2326  
ARLINGTON, VA 22202  
United States

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Int. Cl.: 29

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 1,729,625

Registered Nov. 3, 1992

TRADEMARK  
PRINCIPAL REGISTER

**SYMBIO**  
**LACT**

SYMBIOLACT GMBH (FED REP GERMANY  
CORPORATION)  
KORNMARKT 34  
W-6348 HERBORN-DILL, FED REP GERMANY

FOR: BIOLOGICAL CULTURES AND MEDIA  
FOR USE IN THE PRODUCTION OF FOOD  
PRODUCTS; FOOD PRODUCTS PREPARED  
FROM SUCH CULTURES AND MEDIA;  
NAMESLY, YOGHURT, KEFIR, BUTTERMILK,  
SOUR MILK, CURDLED MILK, SOUR CREAM,  
CURDS, WIEY, CURD CHEESE, BUTTER,

CHEESE, SOYBEAN MILK AND CURDLED OR  
FERMENTED SOYBEAN MILK, IN CLASS 29  
(U.S. CL. 46).

OWNER OF FED REP GERMANY REG. NO.  
1128662, DATED 10-7-1988, EXPIRES 2-11-1998.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "LACT", APART FROM THE  
MARK AS SHOWN.

SER. NO. 74-233,686, FILED 12-27-1991.

MITCHELL FRONT, EXAMINING ATTORNEY

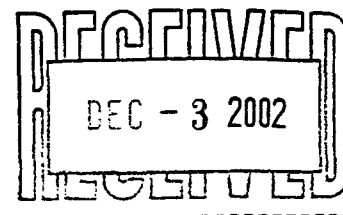
EXHIBIT 2

U.S. Patent and Trademark Office (PTO)  
**NOTICE OF ALLOWANCE**

(NOTE: If any data on this notice is incorrect, please submit a written request for correction of the NOA to: Assistant Commissioner for Trademarks, Box 1TU, 2900 Crystal Drive, Arlington, VA 22202-3513. Please include the serial number of your application on ALL correspondence with the PTO 15 U.S.C. 1063(b)(2))

ISSUE DATE OF NOA: Oct 29, 2002

WILLIAM H. HOLT  
 LAW OFFICES OF WILLIAM H. HOLT  
 UNIT 2, FIRST FLOOR  
 1423 POWHATAN STREET  
 ALEXANDRIA, VA 22314



**\*\* IMPORTANT INFORMATION: 6 MONTH DEADLINE \*\***

To avoid ABANDONMENT of this application, either a "Statement of Use" (a.k.a. "Allegation of Use" or a "Request for Extension of Time to File a Statement of Use" (a.k.a. "Extension Request") and the appropriate fee(s) must be received in the PTO within six months of the issue date of this Notice Of Allowance (NOA) for those goods and/or services based on intent to use. Failure to do so will result in the ABANDONMENT of this application.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements including fees. These requirements are explained in the PTO booklet "Basic Facts About Trademarks", which can be obtained upon request at (703)308-9000. In addition, there are printed forms contained in this booklet (for "Statements of Use" and "Extension Requests") for your use.

The following information should be reviewed for accuracy:

SERIAL NUMBER: 75/583302  
 MARK: SYMBIO LACT (STYLIZED)  
 OWNER: SYMBIO HERBORN GROUP GmbH & Co.  
 Auf don Luppen 8  
 D-35746 Herborn, FED REP GERMANY

This application has the following bases, but not necessarily for all listed goods/service  
 Section 1(a): NO      Section 1(b): YES      Section 44(e): YES

**GOODS/SERVICES BY INTERNATIONAL CLASS**

005-Media for bacteriological cultures for use in the production of dairy products, namely, nutritive substances for said cultures

029-Dairy products prepared with bacteriological cultures and their nutritive substances, namely, milk products containing predominately milk, yogurt, kefir, buttermilk, milk beverages containing predominately milk, sour milk, curdled milk, condensed milk, dried milk, chocolate milk, sour cream, curds, whey, whey based food beverages, peanut milk, curd cheese, and canned soybeans, and in each case may also have added fruits

030-Dairy products prepared from bacteriological cultures and their nutritive substances, namely, milk shakes, coffee based beverages containing milk, edible ices, and ice cream, and in each case may have added fruits

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED



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**At:**  **page: 1 ~ 50)**

("sybio\*") [COMB]

Refine Search

Current Search: S1: ("sybio\*") [COMB] does: 79 occ  
 SS

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
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2	78939075	SYMBIOTRONICS	TARR	LIVE
3	78120144	SYMBIOT	TARR	LIVE
4	78109162	SYMBIOT	TARR	LIVE
5	76310216	2653953 SYMBIOTIN	TARR	LIVE
6	76157777	HR SYMBIONT	TARR	LIVE
7	76344402	SYMBIOSIS	TARR	LIVE
8	76070782	SYMBIOSIS	TARR	LIVE
9	76192268	SYMBIO	TARR	LIVE
10	76311230	2597873 SYMBIO	TARR	LIVE
11	76313658	SYMBIOSIS	TARR	LIVE
12	76362515	SYMBIOSE	TARR	LIVE
13	76284202	SYMBIOT	TARR	LIVE
14	76076818	SYMBION	TARR	DEAD
15	76072059	SYMBIONT NETWORKS	TARR	DEAD
16	75982825	2663882 PRO SYMBIOTICS	TARR	LIVE
17	75411782	SYMBIOTICERAM	TARR	LIVE
18	75459757	2641417 SYMBIO	TARR	LIVE

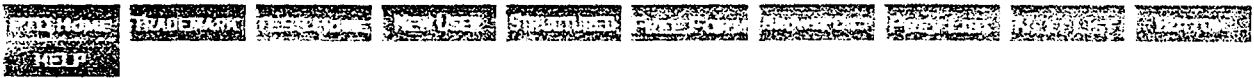
19	<u>75359803</u>		<u>SYMBIOSIS</u>	<u>TARR</u>	<u>LIVE</u>
20	<u>75680726</u>		<u>SYMBIONICS</u>	<u>TARR</u>	<u>DEAD</u>
21	<u>75402400</u>	<u>2622537</u>	<u>SYMBIO</u>	<u>TARR</u>	<u>LIVE</u>
22	<u>75814961</u>		<u>PRO SYMBIOTICS</u>	<u>TARR</u>	<u>LIVE</u>
23	<u>75458080</u>		<u>SYMBIO-THREE</u>	<u>TARR</u>	<u>LIVE</u>
24	<u>75743586</u>	<u>2566426</u>	<u>S SYMBIOTICS THE COLOSTRUM</u> <u>COMPANY</u>	<u>TARR</u>	<u>LIVE</u>
25	<u>75727181</u>	<u>2560919</u>	<u>SYMBIOTICS</u>	<u>TARR</u>	<u>LIVE</u>
26	<u>75600030</u>	<u>2551473</u>	<u>SYMBIO</u>	<u>TARR</u>	<u>LIVE</u>
27	<u>75411277</u>	<u>2538763</u>	<u>SYMBIOBOND</u>	<u>TARR</u>	<u>LIVE</u>
28	<u>75374857</u>	<u>2355744</u>	<u>SYMBIOTIC</u>	<u>TARR</u>	<u>LIVE</u>
29	<u>75955377</u>		<u>PERSONAL SYMBIONT</u>	<u>TARR</u>	<u>DEAD</u>
30	<u>75951036</u>		<u>SYMBIOTIC PERSONALIZATION</u>	<u>TARR</u>	<u>DEAD</u>
31	<u>75951035</u>		<u>PERSONALIZATION SYMBIONT</u>	<u>TARR</u>	<u>DEAD</u>
32	<u>75913178</u>		<u>SYMBION</u>	<u>TARR</u>	<u>LIVE</u>
33	<u>75883597</u>		<u>SYMBIOS CAPITAL</u>	<u>TARR</u>	<u>LIVE</u>
34	<u>75883596</u>		<u>SYMBIOS CAPITAL</u>	<u>TARR</u>	<u>LIVE</u>
35	<u>75805850</u>		<u>SYMBION</u>	<u>TARR</u>	<u>LIVE</u>
36	<u>75764699</u>		<u>SYMBIO</u>	<u>TARR</u>	<u>DEAD</u>
37	<u>75671298</u>		<u>3-DIMENSIONAL SYMBIOTIC</u> <u>MASSAGE</u>	<u>TARR</u>	<u>DEAD</u>
38	<u>75667423</u>	<u>2387279</u>	<u>SYMBIOSIS</u>	<u>TARR</u>	<u>LIVE</u>
39	<u>75623136</u>		<u>SYMBIOTX</u>	<u>TARR</u>	<u>DEAD</u>
40	<u>75592472</u>	<u>2-2-1-87</u>	<u>SYMBIOSIS THE SPIRIT OF</u> <u>INNOVATION</u>	<u>TARR</u>	<u>LIVE</u>
41	<u>75588342</u>		<u>SYMBIO</u>	<u>TARR</u>	<u>LIVE</u>
42	<u>75583411</u>		<u>SYMBIO LACT</u>	<u>TARR</u>	<u>LIVE</u>
43	<u>75583302</u>		<u>SYMBIO LACT</u>	<u>TARR</u>	<u>LIVE</u>
44	<u>75579964</u>	<u>2350496</u>	<u>SYMBIO</u>	<u>TARR</u>	<u>LIVE</u>
45	<u>75464732</u>	<u>2344487</u>	<u>SYMBIOTICS THE COLOSTRUM</u> <u>COMPANY</u>	<u>TARR</u>	<u>LIVE</u>
46	<u>75456297</u>	<u>2275721</u>	<u>SYMBIOT</u>	<u>TARR</u>	<u>LIVE</u>
47	<u>75449023</u>		<u>SYMBIOTICS</u>	<u>TARR</u>	<u>DEAD</u>
48	<u>75411781</u>	<u>2258962</u>	<u>SYMBIOSTAR</u>	<u>TARR</u>	<u>LIVE</u>
49	<u>75411780</u>	<u>2262446</u>	<u>SYMBIOCCLUS</u>	<u>TARR</u>	<u>LIVE</u>
50	<u>75376129</u>	<u>2252787</u>	<u>SYMBIOTROPIN</u>	<u>TARR</u>	<u>LIVE</u>



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page: 51 ~ 79)

("symbio\*") [COMB]

Refine Search

Search results: 79 records found  
 ("symbio\*") [COMB] 88

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
51	75324500	SYMBIOTX	TARR	DEAD
52	75192848	2184826 SYMBIOS	TARR	LIVE
53	75188740	SYMBIOCAL	TARR	DEAD
54	75153107	2441192 SYMBIONTICS	TARR	LIVE
55	75127269	2170111 SYMBIOS COM	TARR	LIVE
56	74507738	1939245 SYMBIONICS	TARR	LIVE
57	74723833	2076816 SYMBIOS LOGIC	TARR	LIVE
58	74646365	2122020 SYMBIOS LOGIC	TARR	LIVE
59	74646364	2122018 SYMBIOS LOGIC	TARR	LIVE
60	74533262	SYMBION	TARR	DEAD
61	74507146	1007367 SYMBIONICS	TARR	LIVE
62	74454371	SYMBION	TARR	DEAD
63	74332433	SYMBIOSIS	TARR	DEAD
64	74298051	1831511 SYMBIOTIC INTELLECT	TARR	DEAD
65	74280181	1762530 SYMBIOTICS	TARR	DEAD
66	74273375	1700764 SYMBIONT. INC COMPUTER AND MANAGEMENT SERVICES	TARR	DEAD
67	74233686	1729625 SYMBIO LACT	TARR	DEAD
68	74106365	1732455 SYMBIOTE	TARR	LIVE

69	<u>74178678</u>	<u>1749729</u>	<u>SYMBIOSE</u>	<u>TARR</u>	<u>LIVE</u>
70	<u>74171593</u>		<u>A SYMBIOTIC RELATIONSHIP BETWEEN SCIENCE AND NATURE</u>	<u>TARR</u>	<u>DEAD</u>
71	<u>73740177</u>	<u>1526494</u>	<u>SYMBIONICS</u>	<u>TARR</u>	<u>DEAD</u>
72	<u>73530203</u>	<u>1362183</u>	<u>WARRIORS OF SYMBION</u>	<u>TARR</u>	<u>DEAD</u>
73	<u>73496166</u>	<u>1334240</u>	<u>SYMBIOSIS</u>	<u>TARR</u>	<u>DEAD</u>
74	<u>73438450</u>	<u>1336522</u>	<u>SYMBIOS</u>	<u>TARR</u>	<u>LIVE</u>
75	<u>73305633</u>	<u>1259060</u>	<u>SYMBIOFLOR</u>	<u>TARR</u>	<u>LIVE</u>
76	<u>73219184</u>	<u>1152832</u>	<u>SYMBIOSE</u>	<u>TARR</u>	<u>LIVE</u>
77	<u>80994048</u>	<u>0094048</u>	<u>SYMBIOSIS</u>	<u>TARR</u>	<u>DEAD</u>
78	<u>72364695</u>	<u>0936254</u>	<u>SYMBIONICS</u>	<u>TARR</u>	<u>DEAD</u>
79	<u>72155355</u>	<u>0756724</u>	<u>SYMBIO</u>	<u>TARR</u>	<u>LIVE</u>

